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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,752	09/12/2003	Corrado Saverio Parmigiani	PARMIGIANI4	5982
1444	7590	02/23/2006	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			SWIGER III, JAMES L	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,752

Applicant(s)

PARMIGIANI, CORRADO
SAVERIO

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/12/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

The claims 8, 13 and 16 are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

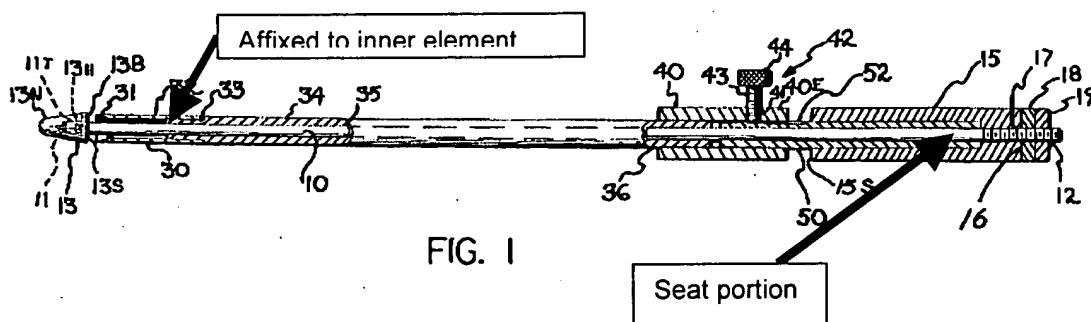
In claim 1, line 3, "its front end portion" is indefinite because it is unclear to what applicant is referring to, e.g., the "handle" or the "scraper blade." It is noted that for examination purposes, it would be treated as referring to the "handle." Furthermore, in line 9, "the outer surface of its front portion" is indefinite because it is unclear to what applicant is referring to, e.g. the "tubular outer casing" or the "inner element."

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Griffin (U.S. Patent No. 4,243,048). Griffin discloses an instrument capable of removing bone having a handle (15) carrying a scraper blade at its front end (13), possessing a collection chamber (32), a handle with an elongate inner element (35), having a proximal end (end adjacent to item 30) with a cylindrical surface (see cutout near item 35), a tubular casing (40) that encloses the inner element (35), a longitudinal rod (10) capable of having a cross section less than that of a collection chamber (32) that has a rear end affixed to the inner element (see Fig. 1 below) and a scraper blade that is affixed to the front of the longitudinal rod (13s).

The device of Griffin is also capable of having the outer casing (30) slide relative

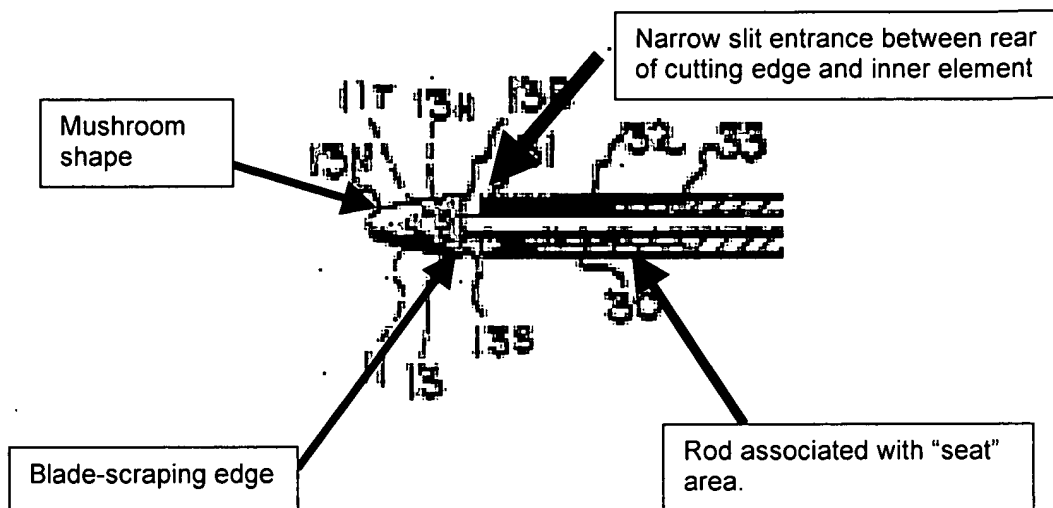


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to the inner element (with 35 and 10 considered inner elements; also Col. 2, lines 56-62). Either object's relative movement to the outer casing yields an exposed collection chamber. The outer casing may also be displaced rearwards while displacing the inner elements forward (see rear end, proximate to item 12, where the handle may be pulled back, but while allowing the rod and inner element to slide forward, allowing the exposure of the collection chamber proximate to item 13s).

The longitudinal rod is also capable of flexing towards the surface of the bone when in use. The rod is constructed of metal (Col 1, line 51), which allows for some flexibility in use towards the bone. Also, because the front scraping element is rounded, significantly matching that of the inner element (see cut-away near item 35), it may be used against the bone radially.

In the enlargement of Fig. 1 below, it can be seen that the front end portion possesses a blade-scraping edge, where the rear face of the scraping edge has a clearance to the front end of the inner element, creating a narrow slit enabling the bone flakes or shavings to pass to the collection chamber. Also, this enlargement also shows that the maximum outer dimension of the scraper is substantially equal to the cross section of the front end portion.



Further, the rod, described as a 'central shaft' (Col. 2, line 20) is capable of having an empty, thin cannula, the end portion of which is capable of being fixed into a "seat." (See Fig. 1 above). Also, the rod is also capable of being forcefully inserted into the front portion of the cannula surrounding the rod. The device also comprises a rear handgrip (15), to which the inner element is joined (see area near 'seat' in above Fig. 1), and wherein the outer casing may slide relative to the inner element. Note that (12) shows the inner element/rod protruding out from the handle, denoting that the rod extends along the entire length of the handle and is free to move longitudinally without restriction in use of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin '048 in view of Altobelli et al. (U.S. Patent No. 5,683,406). Griffin discloses the claimed invention except for a casing that forms a circle-cut along at least one flat side, where the flat side corresponds to the scraping edge. Altobelli et al. disclose a device having a cross section that may be considered partially circle cut (See Fig. 13), and that has the scraping edge in correspondence with the flat side (See Fig. 13, 126). These improvements allow for a more comfortable user orientation so the user may apply downward pressure (Col. 5, lines 28-31), where the tapered width and height allow for a minimally obstructed view of the bone-scraping site (col. 5, lines 19-28), and for a facilitated handling of the instrument (Col. 7, lines 45-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Griffin having at least a casing with a circle-cut on one side and a flat side with a blade in view of Altobelli et al. to better facilitate the using of the instrument in use.

Allowable Subject Matter

Claims 7, 9, 13-14, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

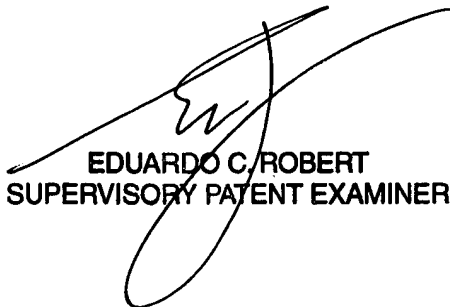
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JLS 2/15/2006


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER